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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,329	12/31/2003	Edgar Matias	P1282US00	8128
54640	7590	09/18/2006	EXAMINER	
PERRY & PARTNERS 1300 YONGE STREET SUITE 500 TORONTO, ON M4T-1X3 CANADA			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	
DATE MAILED: 09/18/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,329

Applicant(s)

MATIAS ET AL.

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment filed 24 August 2006. Claims 6-11 are pending in the application. Claims 1-5 have been canceled.
2. Applicant's arguments against the rejection of the last Office action are persuasive and, therefore, the finality of that action is withdrawn.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

4. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Middlebrooks (US 4,884,692; previously provided).

Middlebrooks discloses a carrying case **10** with adaptable internal dimensions comprising a plurality of internal sidewalls (vertical walls of base **16**), and a plurality of stackable, shock-absorbent spacers **24** removably coupled to one another (Col. 4, lines 55-62).

5. Claims 6, 7, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Shawler (US 4,899,888; provided by applicant).

Claim 6: Shawler discloses a carrying case **10** with adaptable internal dimensions comprising a plurality of internal sidewalls **14, 16, 18 & 20**, and a plurality of

stackable, shock-absorbent spacers **101-106** removably coupled to one another (Col. 4, lines 38-44).

Claim 7: Shawler discloses an adhesive on at least one side of the shock absorbing spacers (Col. 4, lines 41-44).

Claim 10: Shawler discloses lightweight foam (Col. 3, lines 57-61).

Claim 11: Shawler discloses the parallelepiped shape (see Col. 4, lines 33-35 and Figure 2B).

Claim Rejections - 35 USC § 103

6. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shawler as applied to claim 7 above, and further in view of Geary et al (US 6,899,946; hereinafter Geary) and Aileo (US 3,943,572).

Shawler discloses the claimed invention except for the express disclose of the adhesive on both sides of each spacer, in addition to the adhesive being hook-and-loop fasteners.

Shawler discloses the claimed invention except that Shawler uses adhesive instead of hook-and-loop fasteners. Geary shows that hook-and-loop fasteners were an equivalent structure known in the art (see Col. 4, lines 54-59). In order to rely on equivalence as a rationale supporting an obviousness-type rejection, the equivalency must be recognized in the prior art. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). Geary represents evidence that adhesive and hook-and-loop fasteners were art-recognized equivalent structures for connecting layers of foam spacer material.

Therefore, because these two connecting means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute hook-and-loop fasteners for the adhesive of Shawler. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

As to the adhesive on both sides, Aileo teaches the provision of the hook-and-loop fasteners **86/88** on both sides of the foam spacers **82/84** in order to connect two or more shock absorbing pads (see for example Col. 4, lines 24-26 and Figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the hook-and-loop fasteners of Shawler-Geary on both sides of the spacers as taught by Aileo in order to connect two or more spacers.

Response to Arguments

7. Applicant's arguments with respect to the Park reference, filed 24 August 2006, with respect to the rejection(s) of claim(s) 6-11 under 35 U.S.C. 102(b) & 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a new interpretation of Middlebrooks and Shawler, in addition to newly found references Aileo and Geary et al.

Conclusion

8. As the examiner presents new grounds of rejection, this Office Action is made **NON-FINAL**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Greg Pickett
Examiner
7 September 2006


Mickey Yu
Supervisory Patent Examiner
Group 3700